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OFFICE OF PETITIONS

In re Application of :
Alexander S. Kozlov, Derek :
Raybould, Siu-Ching D. Lui, and :
Thomas E. Strangman :
Application No. 10/753,675 : DECISION ON RENEWED PETITION
Filed: January 7, 2004 : PURSUANT TO
Attorney Docket No. H0005756- : 37 C.F.R. § 1.47(A)
1060 :
Title: PLATINUM ALUMINIDE :
COATING AND METHOD THEREOF :
:

This is in response to the renewed petition pursuant to 37 C.F.R. § 1.47(a), filed October 14, 2008.

This renewed petition pursuant to Rule 1.47(a) is **DISMISSED**.

On January 7, 2004, the application was filed, identifying Alexander S. Kozlov, Derek Raybould, Siu-Ching D. Lui, and Thomas E. Strangman as joint inventors. The application was deposited without a fully-executed declaration: the word "deceased" was written on the signature block that is associated with Mr. Kozlov. It appears that this was not picked up by the Office on initial deposit, and the need for a fully executed declaration was first set forth in the Notice of Allowance and Issue Fee Due that was mailed on March 18, 2008.

A grantable petition pursuant to 37 C.F.R. § 1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130 if the

petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(f);

(3) a statement of the last known address of the non-signing inventors;

(4) either

- proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
- proof that the non-signing inventor cannot be found or reached after diligent effort, and;

(5) a declaration which complies with 37 C.F.R. § 1.63.

An original petition pursuant to 37 C.F.R. § 1.47(a) was filed on June 18, 2008, where Petitioner asserted that the non-signing inventor is deceased and that the legal representative of the non-signing joint inventor is unavailable. The petition included, *inter alia*, copies of letters, two declarations of facts, and the last-known address of the legal representative of the non-signing joint inventor.

The original petition was dismissed via the mailing of a decision on August 14, 2008. The decision indicated that the petition was construed to contain a statement setting forth that the legal representative has refused to execute the declaration, and that requirements (1) - (3) of 37 C.F.R. § 1.47(a) had been satisfied. The decision further indicated that an acceptable declaration would need to be provided.

With this renewed petition, Petitioner has included, *inter alia*, two statements of fact, two e-mails from FedEx®, and a declaration that complies with 37 C.F.R. § 1.64(b). As such, requirement (5) of 37 C.F.R. § 1.47(a) has been satisfied.

To date, Petitioner has met requirements (1) - (3) and (5) of 37 C.F.R. § 1.47(a). Petitioner has not met requirement (4), as will now be pointed out.

Regarding the fourth requirement of Rule 1.47(a), the original petition contained an assertion that the legal representative of the non-signing joint inventor is unavailable, and as such, the

decision on the original petition indicated that a complete copy of the application would need to be sent to the last-known address of the legal representative.

With this renewed petition, the situation has changed: Petitioner has now asserted that the legal representative of the non-signing joint inventor cannot be located.¹

Petitioner will note that on the second page of the decision on the original petition, it was indicated that if it is asserted that a non-signing inventor (or in this case, the legal representative thereof) cannot be found or reached, a grantable petition pursuant to 37 C.F.R. § 1.47(a) requires proof that a diligent effort was made to locate this individual.

Due to the fact that Petitioner has now set forth that the legal representative of the non-signing joint inventor cannot be found or reached, Petitioner is required to establish that a diligent effort was made to locate the legal representative of the non-signing joint inventor. The petition is silent as to any search that might have been performed for the legal representative of the non-signing joint inventor. There is no indication that the Rule 47 applicant attempted to verify her address or to determine her forwarding address, and to send the complete application papers to that address for consideration by the legal representative of the non-signing joint inventor.² Petitioner must provide a showing detailing the attempts that were made to obtain a forwarding address or to locate the legal representative of the non-signing joint inventor by means such as through E-mail, telephone, and the Internet. If this search is sufficiently broad so as to provide a reasonable chance at locating this individual, and it is then averred that such attempts failed, then Petitioner will have provided the necessary proof required under 37 C.F.R. § 1.47 that the legal representative of the non-signing joint inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Any renewed petition must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Second Renewed Petition pursuant to 37 C.F.R.

¹ Petition, page 2. See also Kwacala declaration of facts, paragraphs 4 and 6, Hale declaration of facts, paragraph 3, and accompanying e-mails from FedEx®.

² See MPEP §409.03(d).

§ 1.47(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

The second renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,³ hand-delivery,⁴ or facsimile.⁵ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.⁶

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

The general phone number for the Office of Petitions that should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.⁷ All other inquiries concerning

³ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁴ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

⁵ (571) 273-8300- please note this is a central facsimile number.

⁶ <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

⁷ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).

examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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